

## REMARKS

In the Office Action mailed from the United States Patent and Trademark Office on June 16, 2004 the Examiner rejected claims 24-30 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,172,328 issued to Jones (“Jones”), or as anticipated by U.S. Patent No. 5,305,550 issued to Skonecki (“Skonecki”), and rejected claims 11-15 and 21-23 under 35 U.S.C. 103(a) as being unpatentable over Jones or Skonecki. Accordingly, Applicant respectfully provide the following:

### Rejections under 35 U.S.C. 102

The standard for a Section 102 rejection is set forth in M.P.E.P 706.02, which provides “the reference must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present.”

In the Office Action mailed from the United States Patent and Trademark Office on June 16, 2004 the Examiner rejected claims 24-30 under 35 U.S.C. 102(b) as being anticipated by Jones, or by Skonecki. The Examiner indicated that Jones teaches an organic product such as flower or petals, which may be in a natural configuration in which the organic product may be marked/etched with a device/laser/galvanometer. The Examiner indicated that Jones’ flower is natural, because Jones is concerned with the ability of the leaf to photosynthesize and respire, even when the design is provided on the surface of the flower. Therefore, the Examiner concluded that Jones’ flower is in an undamaged form. The Examiner indicated that Skonecki teaches an organic product in a natural configuration, with a personalized message or drawing inscribed on one of its petals. The Examiner indicated that Skonecki teaches the use of a pilot pen to write on the surface of the petal, wherein a fine line of paint is applied, which dries almost instantly upon contact with the surface of the petal.

Applicant respectfully submits that the cited references do not teach every aspect of the amended claim set as provided herein, and therefore do not anticipate the claims of the present

invention. In particular, Claim 24 has been amended to include the following claim limitations: [1] a group of flowers; [2] free from damage from etching, laser and pressure; [3] detached petals; [4] an overlaid image, [5] a repeatable image; [6] an identical image; [7] a pad printed image, and [8] where an image is overlaid on each group of said flowers. Applicant submits that the cited references do not teach every element of the claimed invention, as amended, and thus do not bar the claimed invention as a public use of the invention more than one year prior to the date of application.

Skonecki does not teach or suggest all of the claim limitations present in the current application. Claim 24 of the present invention includes the limitation “an overlaid, repeatable, identical pattern and image wherein said image is overlaid on each of a group of said flowers.” Skonecki teaches a method for using a handheld applicator to draw on the petals of a fresh natural flower. Because Skonecki teaches the use of a handheld applicator, Skonecki does not teach an invention that is capable of a “repeatable, identical pad-printed image.” In particular, Skonecki teaches the use of an extra fine point tip pilot pen for the application of paint to the exterior of a fresh natural flower. Because Skonecki teaches a handheld applicator, it is impossible to consistently repeat an identical image on each subsequent flower, in a group of flowers, as claimed in the present invention.

Because Skonecki teaches a process utilizing a handheld applicator, Skonecki does not teach an overlaid image as is presently claimed in Claim 24 of the present invention. Skonecki teaches the use of an extra fine point tip pilot pen for the application of paint to the exterior of a fresh natural flower. Skonecki does not teach a process for transferring a image onto an organic product by rolling the surface of the pad that includes the negative image onto the surface of an organic product. *Specification*, at 10.

Claim 24 of the present invention includes limitations for a flower free from etching, laser or pressure. Skonecki does not teach a method that produces a flower completely free from damage. Skonecki's handheld application will be performed with inconsistent pressures. When more than slight pressures are applied with the pen, damage will be caused to the fresh natural flowers. Thus, Skonecki does not teach all of the limitations present in the current application.

Jones fails to teach all of the claim limitations present in the current application. Jones teaches a method for etching, cutting and altering the surface of flowers and other foliage, with a computer controlled laser. Plants are comprised of living cellular matter. When the laser contacts the surface of a plant a mark is made on the surface of the plant only to the extent that the laser superheats, effectively incinerating, a series of cells in a predesigned pattern. Thus, Jones teaches a method for using a laser to destroy selected cellular patterns on the surface of plants to produce an image visible to the human eye. Jones teaches a method for damaging the cellular surface of a flower to produce an image similar to branding an animal, where high heat produces scarring. Therefore, Jones fails to teach "a group of flowers wherein each of the group of flowers is free from damage from etching, laser and pressure."

Because Jones teaches the use of a laser to incinerate the cellular surface of foliage, Jones does not teach an image, which is overlaid on the surface of the flower as claimed in Claim 24 of the present invention. The repeatable image claimed by the present invention does not damage, remove or otherwise affect the cellular surface of foliage. Rather the present invention teaches a product, wherein a desired image is overlaid on to a surface of a flower so as preserve the cellular integrity of the flower. The present invention teaches a product, produced by a method of gently overlaying an image on the delicate cellular matter of a flower. The product of the present invention is additive; a flower with no damaged cells is added to an overlaid image by a delicate repeatable process Jones'

process results in a product that results from a destructive process. Instead of overlaying an image on a flower that has no cellular damage, Jones teaches a method of destroying the cellular tissues of a flower to produce an image.

As Jones and Skonecki fails to teach overlaying an image onto an organic product as taught by the present invention, Jones and Skonecki fail to anticipate the present invention as claimed. Accordingly, Applicant respectfully requests withdrawal of rejections of claims 24-30 under Section 102.

#### Rejections under 35 U.S.C. 103

An invention is unpatentable under Section 103(a) “if the differences between the subject matter sought to be patented over the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.” To establish a *prima facie* case of obviousness, three criteria must be met.

First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991); M.P.E.P. § 2142.

In the Office Action mailed from the United States Patent and Trademark Office on June 16, 2004 the Examiner rejected claims 11-15 and 21-23 under 35 U.S.C. 103(a), as being unpatentable over Jones or Skonecki. The Examiner indicated that Skonecki teaches an organic product such as a fresh natural flower marked with a personalized message or drawing inscribed on one of the petals. The Examiner indicated that Jones teaches an organic product such as a flower, in which the organic

product may be marked/etched with a device/laser/galvanometer. Applicant respectfully submits the references cited by the Examiner do not teach or suggest the limitations claimed in the present invention and that secondary considerations militate toward finding the present invention nonobvious.

Claim 11 and subsequent claims have been amended from “organic product ... comprising a group of flowers each having placed thereon an overlaid identical pad printed image wherein each of the group of flowers is in an undamaged natural configuration” to “[a]n organic product having an image thereon, the product comprising: a group of flowers, wherein each of the group of flowers is free from etching, and laser exposure and pressure; and a repeatable, identical, pad-printed image overlay, wherein said image is overlaid on each of the group of said flowers.”

The claims of the present invention have several limitations that are not taught or suggested in Jones or Skonecki. Jones or Skonecki fail to teach the claim limitation “free from damage from etching, laser and pressure.” Further, Jones or Skonecki fail to teach “a repeatable, identical, pad-printed image overlay, wherein said image is overlaid on each of the group of said flowers.”

As previously mentioned, Skonecki teaches a method of applying a personalized message to a rose utilizing a hand held applicator. The Skonecki patent does not teach a group of flowers each having placed thereon an overlaid identical pad-printed image wherein each of the flowers in the group of flowers is in an undamaged natural configuration. In column 1, line 32, the Skonecki patent indicates that, “[a] unique individualized message or drawing can be easily applied to the petal to mark a special occasion.” Uniqueness indicates non-reproducibility. Because Skonecki teaches the use of a hand held applicator, Skonecki teaches a method that is incapable of “producing a *repeatable identical pad printed image overlay*” (emphasis added). Because Skonecki teaches a method that utilizes a hand held applicator it is impossible to identically reproduce an image over

and over again on each separate flower in a group of flowers. Further, utilizing a hand held applicator is not a pad printed image; Skonecki teaches a drawn image. Because Skonecki teaches the use of a hand held applicator, operator error will result in excess pressure applied to the cellular tissues of the rose, producing cellular damage. Thus, Skonecki does not teach a method wherein the overlaid image on said flowers is produced without damaging the natural configuration of flowers. Skonecki teaches in Column 2, lines 14 through 20 that care must be taken to avoid damaging the petal. It states, “[a]ll the pens in the group are operable to enable the paint to flow from a tip thereof onto the petal by applying minimal pressure to the petal with the tip, thereby preventing damage to the pedal [sic].” Skonecki teaches that if more than minimal pressure is applied damage will occur. Since the Skonecki process is performed by a human, there is a chance that the Skonecki process can result in more than minimal pressure being applied thereby damaging the petal. This is in contrast to the presently claimed invention wherein each flower has “a repeatable, identical, pad-printed image overlay, wherein said image is overlaid on each of the group of said flowers.” Because of the pad-printing process, the pressure is dispersed over a wide area thereby preventing unnecessary pressure being applied to the rose.

Jones teaches a method which fails to teach or suggest all the claim limitations of the present invention. Jones as previously mentioned teaches a method of etching, cutting or altering the surface of a flower with a computer controlled laser. As previously mentioned, the design produced by Jones on the surface of a flower is only visible to human eye to the extent that damage, by a laser, has occurred to the cellular surface of the flower. Thus, Jones does not teach a method wherein the overlaid image on said flowers is produced without damaging the natural configuration of flowers. The abstract for the ‘328 Jones patent begins, “[m]ethods are provided for etching, cutting, and/or altering the surface of a flower ...”. This is done with laser energy to affect a marking of the foliage.

It occurs by thermally disrupting plant tissue to cause a permanent mark on the foliage surface. Jones does not teach a group of flowers each having placed thereon an overlaid identical pad-printed image wherein each of the group of flowers is in a natural undamaged configuration. Instead, Jones teaches a group of flowers that have etched, cut or altered surfaces which have been disrupted on their surfaces or have been cut by the laser beam.

Thus, Applicant submits that it would not have been obvious to one of ordinary skill in the art at the time the invention was made to provide identical pad-printed images on a group of flowers, because such identical images are not possible using the Skonecki reference; and although identical images could be provided by the Jones reference, it cannot be provided without damaging the natural configuration of the flowers.

#### Secondary Considerations of Non-Obviousness

Under Section 103, objective evidence or secondary considerations such as unexpected results, commercial success, long-felt need, failure of others, copying by others, licensing, and skepticism of experts are relevant to the issue of obviousness and must be considered in every case in which they are present. M.P.E.P. § 2141.

Although the present invention is not obvious as discussed above, secondary considerations are presented as further evidence of nonobviousness. Applicant has had considerable commercial success, and success in finding partners for licensing agreements. The considerable success in finding partners for licensing agreements demonstrates the commercial success of embodiments of the present invention flows from the functions, and advantages disclosed in the description in the specification, and that the commercial success is due to the claimed features, otherwise, licensing agreements would not be necessary. The following are examples of this success and are supported by the declarations previously submitted to the Examiner on June 14, 2004.

## Licensing

On June 14, 2004 a supplemental response was submitted to the Examiner. The supplemental response was attached to four Declarations from merchants currently selling the claimed invention. The Declarations were submitted to support Applicant's position that the claimed invention is not obvious and does fulfill a long felt need in that it has received significant commercial success, because of the elements set forth in the claims of the present invention. The Examiner is respectfully requested to review the supplemental response mailed June 14, 2004 in association with the present Amendment. In the Declarations attached to the supplemental response each Declarant indicates that the Licensee's licensing agreement demonstrates that a long felt need exists in the industry for the ability to personalize a live rose by printing thereon without damaging the product in the printing process.

Applicant has entered into a licensing contract with Taylor Corporation, which is the largest wedding card printing company in the nation with over 87% of the nation's wedding card printing business.

Applicant has also licensed its product to GiftTree ([gifttree.com](http://gifttree.com)), a large corporate and public web site who features and sells Applicant's product on a daily basis.

FTD.com also licensed Applicant's product several months ago and features and sells Applicant's product as well. Discussions are currently under way to formally license all 22,000 of FTD's licensed retail florists. On September 15-17, 2003, Applicant trained all twenty of the FTD in-house sales individuals who will begin the formal individual licensing of their 22,000 stores under the Master License Agreement with FTD.

USA Bouquet, based in Miami, Florida has also licensed Applicant's product. USA Bouquet has offices in Atlanta and Chicago for the fulfillment of current orders. Each of these facilities has



Applicant's printing and engraving equipment on site. These three facilities fulfill all orders placed anywhere in the Continental United States for next day delivery.

Chicago-based Kennecott Brothers has also licensed Applicant's product. Kennecott Brothers services 1800 retail establishments as well as several large Super Floral groups like Jewel Osco/Albertsons. Kennecott Brothers has licensed Applicant's equipment, both the printers and the engravers. Applicant is currently setting up 2200 stores under the license agreement with Albertsons through the Kennecott Brothers fulfillment center in Chicago. Under separate and individual license agreements, Albertsons is planning to open 200 stores in September, 200 stores in each of October, November, and December and 1400 stores in the month of January.

In addition, Applicant has licensed over 80 individual retail shops around the nation with the capacity to print flowers on their own premises.

Also, Sam's Club, a division of Wal-Mart Corp., the largest retail corporation in the world, has licensed Applicant's product, initially going out to their Scent Express base of 30 million corporate customers.

Applicant has entered into an agreement with Publix's 850 retail outlets to begin immediately enrolling and training each of their individual stores.

Applicant is currently concluding agreement discussions with Golden Rose, the largest rose distributor in Canada, to make them a licensed distributor for the entire country of Canada.

The Zuriel group in Holland has agreed to represent Applicant in the twenty-two European countries they currently service. They have 167 refrigerated trucks that are going daily to a larger market than the entire United States floral market.

The Regent Hotel in Anaheim, California has also licensed Applicant's product. Regent Hotel is a large hotel group that is beginning to introduce Applicant's product to their 700 sister five-star hotels around the world to be used for special events.

The largest wholesalers in the nation have been approved to license Applicant's product, including Delaware Valley in the Northeast, Denver Floral Wholesale in the Northwest and through Colorado, and Mellano, who services Southern California and all of Nevada.

Additionally, Applicant has individual contracts with various other stores and corporations and is beginning to license individual "event planners" around the nation who represent the large corporate events and large wedding planners who have need on special occasion for large quantities of flowers that are personalized and customized for specific use.

Applicant's considerable success in finding partners for licensing agreements shows the commercial success of embodiments of the present invention flows from the functions and advantages disclosed in the description in the specification and that the commercial success is due to the claimed features, otherwise it would not have been necessary for the many organizations listed above to enter into licensing agreements with Applicant.

#### Commercial Success

Applicant's licensing agreement with FTD.com currently generates sales of approximately seventy dozen flowers a day. A substantial increase in sales is expected once discussions are completed, formally licensing all 22,000 of FTD's licensed retail florists.

Regent Hotel has started using Applicant's product at some of its large events, such as a \$100,000 event it holds twice a week.

In addition, Applicant has developed an extensive sales and marketing network. This network includes: Taylor Corporation, the United States market share leader in wedding cards; Giftree.com, a

large corporate and public web site that sells Applicant's products on a daily basis; USA Bouquet, who sells and delivers Applicant's products nationally; Kennecott Brother's 1800 retail establishments and its large Super Floral groups including Jewel Osco/Albertsons, that will be selling Applicant's products in 2200 stores by January, 2004; 80 individual retail shops; Sam's Club, exposing Applicant's product to 30 million corporate customers; Publix's 850 retail outlets; Golden Rose, the largest rose distributor in Canada; the Zuriel group in Holland, who services twenty-two European countries; the largest wholesalers in the United States, including Delaware Valley in the Northeast, Denver Floral Wholesale in the Northwest and through Colorado, and Mellano, who services Southern California and all of Nevada; and other individual planners of large corporate events and weddings.

Applicant's considerable success in establishing its extensive sales and marketing network by finding partners for licensing agreements shows the commercial success of embodiments of the present invention flows from the functions and advantages disclosed in the description in the specification and that the commercial success is due to the claimed features, otherwise it would not have been necessary for the many organizations listed above to enter into licensing agreements with Applicant.

#### Long-Felt Need

The present invention also solves the long-felt need for a repeatable, rapid method for laying a design onto a flower that preserves the integrity of the flower. Evidence of this long-felt need is found in Skonecki, which documents this need dating back to 1993. See Skonecki, Column 2, lines 16-18. Applicant's success in licensing its product further shows this long-felt need was not solved by Skonecki and shows that Applicant's product solves this long-felt need.

In conclusion, the differences between Skonecki and the present invention are substantial. These differences, together with Applicant's commercial success, many licensing agreements and solution to a long-felt need show the present invention is non-obvious.

Accordingly, Applicant respectfully requests withdrawal of the rejections of claims 11-15 and 21-23 under Section 103 as being unpatentable over Skonecki or Jones.

#### CONCLUSION

Applicants submit that the amendments made herein do not add new matter and that the claims are now in condition for allowance. Accordingly, Applicants request favorable reconsideration. If the Examiner has any questions or concerns regarding this communication, or if the Examiner would like to suggest amended claim language, the Examiner is invited to call the undersigned.

DATED this 16 day of September, 2004.

Respectfully submitted,



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